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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/894,207	06/28/2001	Zvi Bleier	148/1	7104

27538 7590 02/25/2003

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[REDACTED] EXAMINER

SHAFER, RICKY D

ART UNIT	PAPER NUMBER
2872	

DATE MAILED: 02/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.	09/894,207	Applicant(s)	BLEIER
Examiner	R.D. SHAFER	Group Art Unit	2872

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 month MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- Responsive to communication(s) filed on 6/28/01
- This action is FINAL.
- Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

- Claim(s) 1 - 45 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- Claim(s) \_\_\_\_\_ is/are allowed.
- Claim(s) \_\_\_\_\_ is/are rejected.
- Claim(s) \_\_\_\_\_ is/are objected to.
- Claim(s) 1 - 45 are subject to restriction or election requirement

### Application Papers

- The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.
- The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner
- The specification is objected to by the Examiner.
- The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119 (a)-(d)

- Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- All  Some\*  None of the:
- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- Copies of the certified copies of the priority documents have been received  
in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

### Attachment(s)

- Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_  Interview Summary, PTO-413
- Notice of Reference(s) Cited, PTO-892  Notice of Informal Patent Application, PTO-152
- Notice of Draftsperson's Patent Drawing Review, PTO-948  Other \_\_\_\_\_

## Office Action Summary

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1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 2, 3, 11-20, 22 and 30-38, drawn to a lateral transfer retroreflector assembly comprising a mirror panel housing, a roof mirror assembly and a connecting member with particular roof mirror assembly details, classified in class 359, subclass 861.
  - II. <sup>(9, 20)</sup> Claims 4-10, drawn to a lateral transfer retroreflector assembly comprising a mirror panel housing, a roof mirror assembly and a connecting member with particular mirror panel housing details, classified in class 359, subclass 861.
  - III. Claims 23-29, drawn to a lateral transfer retroreflector assembly comprising a mirror panel housing, a roof mirror assembly and a connecting member with particular mirror panel housing and roof mirror assembly and details, classified in class 359, subclass 861.
  - IV. Claims 39-43, drawn to a roof mirror assembly comprising a first mirror panel, a second mirror panel and at least one mounting block with particular first and second mirror panel details, classified in class 359, subclass 857.
  - V. Claims 44 and 45, drawn to a method of assembling a lateral transfer retroreflector assembly, classified in class 359, subclass 861.
2. Claim 1 link(s) inventions I-III. The restriction requirement among the linked inventions is subject to the nonallowance of the linking claim(s), claim 1. Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any

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claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

Claim 21 link(s) inventions I and III. The restriction requirement among the linked inventions is subject to the nonallowance of the linking claim(s), claim 21. Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

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3. The inventions are distinct, each from the other because of the following reasons:

Inventions IV and [(I), (II), (III)] are related as combination and subcombination.

Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because of the omission of the particular first and second mirror panel details. (Note by example claim 1). The subcombination has separate utility such as a roof mirror assembly without a mirror panel housing or connecting member.

Inventions III and I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because of the evidence of claim 4. The subcombination has separate utility such as a lateral transfer retroreflector assembly without the particular roof mirror assembly details.

Inventions III and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination

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as claimed does not require the particulars of the subcombination as claimed because of the evidence of claim 2. The subcombination has separate utility such as a lateral transfer retroreflector assembly without the particular mirror panel housing details.

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, each of the inventions I and II have separate utility such as a lateral transfer retroreflector assembly with the separate details of the other invention(s). For example, the lateral transfer retroreflector assembly of group I has a separate utility as an lateral transfer retroreflector assembly without the particular mirror panel housing details of group II and the lateral transfer retroreflector assembly of group II has a separate utility as an lateral transfer retroreflector assembly without the particular roof mirror assembly details of group I. See MPEP § 806.05(d).

Inventions V and [(I), (II), (III)] are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus as claimed can be used to practice another and materially different process such as one that does not require adhering a mirror panel to said first and second side members (i.e. such as clamping the mirror panel to said first and second side members.

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4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification above, their recognized divergent subject matter or the search required for one of the inventions I-V is not coextensively required for any of the remaining inventions I-V, as stated below. Therefore, restriction for examination purposes as indicated is proper.

The search required for invention I would further require a search in class 359, subclass 856 which would not be required for inventions II and V.

The search required for invention II would further require a search in class 359, subclass 871 which would not be required for inventions I, IV and V.

The search required for invention V would further require a search in class 359, subclass 900 which would not be required for inventions I-IV.

5. This application contains claims directed to the following patentably distinct species of the claimed invention:

- A). The roof mirror species depicted by Fig. 9; and
- B). The roof mirror species depicted by Fig. 13.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, several claims are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon,

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including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

6. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to R.D. Shafer whose telephone number is (703) 308-4813.

RDS

February 22, 2003

*Ricky D. Shafer*  
RICKY D. SHAFER  
PATENT EXAMINER  
ART UNIT 2872